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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/505,440	08/24/2004	Eberhard Ammermann	3165-107	2309

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EXAMINER

PURDY, KYLE A

ART UNIT

PAPER NUMBER

1611

NOTIFICATION DATE

DELIVERY MODE

06/03/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTO-PAT-Email@rfem.com

# Office Action Summary

**Application No.**

10/505,440

**Applicant(s)**

AMMERMAN ET AL.

**Examiner**

Kyle Purdy

**Art Unit**

1611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03/24/2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4, 7-9 and 11-14 is/are pending in the application.
- 4a) Of the above claim(s) 3, 4, 8, 9, 12 and 13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 7, 11 and 14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

#### **DETAILED ACTION**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 03/24/2009 has been entered.

#### ***Status of Application***

2. The Examiner acknowledges receipt of the amendments filed on 03/24/2009 wherein claims 1, 2, 7 and 11 have been amended and claim 14 is newly added. Claims 3-4, 8-9 and 12-13 remain withdrawn from consideration as being drawn to a non-elected invention and/or species.

3. Claims 1, 2, 7, 11 and 14 are presented for examination on the merits. The following rejections are made.

#### ***Response to Applicants' Arguments***

4. Applicants arguments filed 03/24/2009 regarding the rejection of claims 1, 2, 7, 11 and 14 made by the Examiner under 35 USC 103(a) over Wachendorff-Neuman et al. (US 6787567) have been fully considered but they are not found persuasive.

5. The rejection of claims 1, 2, 7, 11 and 14 made by the examiner under 35 USC 103(a) is **MAINTAINED** for the reasons of record in the office action mailed on 10/27/2008.

6. In regards to the 103(a) rejection, Applicant asserts the following:

A) The claims have been amended so as to exclude the methoximinoacetamide compound taught by Wachendorff by using "consisting essentially of" language.

**B)** The claims have been amended to require the composition to be synergistic, which is not taught by the reference.

7. With respect to A, the Examiner disagrees. Applicant does not properly define “consisting essentially of”. The Examiner acknowledges that the transitional phrase “consisting essentially of” limits the scope of a claim to the specific materials or steps “and to those that do not materially affect the basic and novel characteristics” of the claim invention. However, absent a clear indication by Applicants specification of what the basic and novel characteristics actually are, “consisting essentially of” will be construed as equivalent to “comprising”. If Applicant contends that additional materials in the prior art are excluded by the use of such language, Applicant has the burden of showing that the introduction of additional steps or components would materially change the characteristics of Applicants invention. See MPEP 2111.03. Thus, in view of the MPEP, the present claims will be construed as equivalent to “comprising” claims as Applicant has failed to set forth a definition clearly defining what additional materials would materially affect Applicants composition. Applicants argument is not found persuasive.

8. With respect to B, the Examiner disagrees. Wachendorff teaches a mathematical formula for making fungicidal compositions which will exhibit synergistic activity. See column 28. One would have been motivated to apply the mathematical formula to any mixture of fungicides in order to arrive at a mixture that had synergistic effects. For instance, if one arrived at a composition comprising prothioconazole and another fungicide exemplified by Wachendorff, i.e. trifloxystrobin, at a ratio somewhere between 20:1 and 1:20 which exhibited synergistic properties, then this would not be a product of innovation, but rather one of common sense and ordinary skill. Applicants argument is not found persuasive.

***Claim Objections***

9. Claim 1 is objected to because of the following informalities: misspelling of 'essentially'. Currently, Applicant has is spelled as 'essentially'. Appropriate correction is required.

**Maintained Rejections (claims 1, 2, 7 and 11) and New Rejections (claim 14)**  
***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. **Claims 1, 2, 7, 11 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wachendorff-Neumann et al. (US 6787567; of record).**

12. The teaching of Wachendorff-Neuman et al. ('Wachendorff') is drawn to fungicidally active compound combinations. It is disclosed that prothioconazole (compound XXI, see column 6, lines 5-10; see instant claims 1 and 2) and trifloxystrobin (compound XII, see column 4, lines 20-25; see instant claims 1 and 2) are fungicides which can be used in the active combination. It is taught that the active fungicidal compound combinations are present in a solid or liquid carrier (see column 26, lines 62-68; see instant claim 11). Wachendorff teaches that prothioconazole and trifloxystrobin can be included in a fungicidal composition, preferably from 0.2 to 20 parts by weight (see column 22, lines 50 and line 66: specifically groups 12 and 20; see instant claim 7).

13. Wachendorff fails to specifically use prothioconazole and trifloxystrobin together in a composition.

14. Regardless, it would have been obvious to one ordinarily skilled in the art at the time the invention was made to use and modify the teaching of Wachendorff with a reasonable expectation for success in arriving at a active fungicidal mixture wherein the mixture comprises prothioconazole and trifloxystrobin. Although the teaching of Wachendorff doesn't specifically teach using the compounds together, it would still have been obvious to combine them and arrive at a composition having the instant properties. According to the MPEP (2144.06), it is *prima facie* obvious to combine two compounds each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose. So even though Wachendorff fails to use the two compounds together, the mere fact that both compounds are commonly used as fungicides, one of ordinary skill would have motivated to combine them with a reasonable expectation for success in arriving at a composition with the instantly claimed properties. Moreover, Wachendorff states that the amount each fungicidal component to be used in a composition ranges from 0.2 to 20 parts by weight which would result in a weight ratio of 1:1 to 100:1 (or 1:100) which covers the broad range claimed by Applicant. It is not considered inventive to optimize compositions (per weight ratio) especially when the conditions of such a composition are clearly suggested by the prior art. Therefore, a composition which comprises prothioconazole and trifloxystrobin at a weight ratio of 20:1 to 1:20 is *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in absence of evidence to the contrary.

15. As was discussed in paragraph 4 above, because Applicant has failed to define what materially affects the claimed composition, "consisting essentially of" will be construed as equivalent to "comprising."

***Conclusion***

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kyle A. Purdy whose telephone number is 571-270-3504. The examiner can normally be reached from 9AM to 5PM.

17. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharmila Landau, can be reached on 571-272-0614. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

18. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*/Kyle Purdy/  
Examiner, Art Unit 1611  
May 27, 2009*

*/David J Blanchard/  
Primary Examiner, Art Unit 1643*